

#30

DATE: May 27, 1997TELECOPIER TRANSMITTAL SHEETPLEASE DELIVER THE FOLLOWING 2 PAGES (INCLUDING THIS PAGE)TO: Asst. Commissioner for Patents - Special Program Law OfficeTELECOPIER TELEPHONE NUMBER: 703/308-6916FROM: DR. THOMAS D. HOFFMAN TELEPHONE NO.: (908)298-5037

SCHERING-PLOUGH CORPORATION

KENILWORTH, NEW JERSEY 07033

*FAX RECEIVED  
MAY 27 1997  
SCHERING-PLOUGH CORPORATION*

CONFIDENTIALITY NOTE: This sheet and/or the document(s) accompanying it contain information belonging to Schering-Ploough Corporation which is confidential and/or legally privileged. The information is intended only for the use of the individual or entity named above. If you have received this telecopy in error, please immediately notify us by telephone.

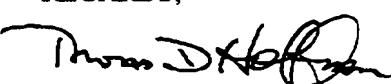
If there is a problem with this transmission,  
please call (908)298-5037.

Our telecopier number is: (908)298-5388.

COMMENTS:

Re: Request for reconsideration:  
Patent Term Extension Application  
for U.S. Patent No. 4,634,697  
for CEDAX® (Oral Suspension)  
FDA Docket No.: 96E-0099

REGARDS,



THOMAS D. HOFFMAN,  
SENIOR SPECIALTY COUNSEL  
SCHERING-PLOUGH CORPORATION  
KENILWORTH, NJ, USA

TDH/mjs

## SCHERING CORPORATION

CALLOPING HILL ROAD



KENILWORTH, N.J. 07033

CABLES: SCHERING-KENILWORTH  
TELEX: 138316  
138280  
TELEPHONE: (908) 298-4000

May 27, 1997

Assistant Commissioner for Patents  
Box Patent Extension  
Washington, D.C. 20231  
Attn: Special Program Law Office

**FAX RECEIVED**  
RE: MAY 27 1997  
**PETITIONS OFFICE**  
Sir:

Request for reconsideration:  
Patent Term Extension Application  
for U.S. Patent No. 4,634,697  
for CEDAX® (Oral Suspension)  
FDA Docket No.: 96E-0099

Schering Corporation ("Applicant" or "Schering") respectfully requests reconsideration of the PTO Notice of Final Determination, dated April 25, 1997 (enclosed), in the above-referenced application. Specifically, Schering takes issue with the conclusion in the aforesaid Notice that Schering's election to have U.S. Patent No. 4,812,561 ("the '561 patent") extended renders U.S. Patent No. 4,634,697 (the '697 patent) ineligible for extension, despite the fact that the '697 patent meets all the statutory requirements for extension. The Schering request for reconsideration of the aforesaid Notice of Final Determination with respect to the '697 patent is without prejudice to the Schering election, filed on this date under separate cover, to have the '561 patent extended (FDA Docket No. 96E-0100).

Both the '697 patent and the '561 patent claim the human drug product CEDAX® (active ingredient: ceftifibuten dihydrate). CEDAX® was the subject of two separate regulatory review periods, one for a capsule product (NDA No. 50-685), and one for an oral suspension product (NDA No. 50-686). The regulatory review period for the capsule product commenced on August 1, 1987; and the regulatory review period for the oral suspension product commenced on September 28, 1988. Both regulatory review periods ended on the same day, and the FDA granted permission for commercial marketing or use for both products in a letter to Schering dated December 20, 1995 (Exhibit VII of the above-referenced application). Accordingly, Schering filed one application for patent term extension for each of the

- 2 -

'561 patent and the '697 patent based on each of the two separate regulatory review periods, for a total of four patent term extension applications.

Although all of the Notices of Final Determination on these applications suffer from the same flaw, namely that they all failed to acknowledge that there were two separate regulatory review periods for the two CEDAX® products, Schering is specifically requesting extension of the '697 patent based on the regulatory review period for the CEDAX® oral suspension product and therefore requests reconsideration of the PTO's requirement in each of the Notices of Final Determination that Schering elect a single patent and a single review period. For example, in the Notice of Final Determination for the '697 patent based on the regulatory review period for the CEDAX® oral suspension product, the PTO found that (1) the '697 patent is eligible for patent term extension under 35 U.S.C. § 156; (2) the period of extension is to be five years; and (3) the expiration date after extension will be October 1, 2009. Nevertheless, the aforesaid Notice of Final Determination also concluded that only one of the '561 patent or the '697 patent may be extended on the basis of either of the two regulatory review periods. Because Schering has elected to extend the '561 patent term on the basis of the CEDAX® capsule regulatory review period, the aforesaid Notice of Final Determination precludes Schering from extending the '697 patent term on the basis of the CEDAX® oral suspension regulatory review period.

In support of its conclusion, the PTO in the aforesaid Notice of Final Determination cites 35 U.S.C. §§ 156(c)(4) and 156(a)(5). Section 156 (c)(4) provides that "in no event shall more than one patent be extended...for the same regulatory review period for any product" 35 U.S.C. §156 (c)(4) (emphasis added). As discussed above, the regulatory review periods for the CEDAX® capsule product and the CEDAX® oral suspension product are different, and Schering has elected, in a letter filed today under separate cover, to extend the '561 patent based on the regulatory review period for the CEDAX® capsule product. Accordingly, the regulatory review period for the oral suspension product may properly form the basis for extending the term of the '697 patent without violating Section 156 (c)(4), and Schering has also elected to extend the '697 patent on that basis.

Section 156(a)(5) requires that "the permission for commercial marketing or use of the product after [the] regulatory review period is the first permitted commercial marketing or use of the product...." 35 U.S.C. §156 (a)(5). In this case, the first permitted commercial marketing or use of the CEDAX® product was granted by the FDA in its December 20, 1995 letter, which approved use of CEDAX® in both its capsule and oral suspension forms. Thus, a straightforward application of §156 (a)(5) provides no basis for denying the Schering request that the '697 patent be extended on the basis of the CEDAX® oral suspension regulatory review period--it is undeniable that "the permission for commercial marketing or use of the product" after that regulatory review period was "the first permitted commercial marketing or use" of the CEDAX® product.

- 3 -

For the foregoing reasons, Schering urges reconsideration, withdrawal of the requirement to elect a single patent and a single regulatory review period, and a favorable decision on the Schering request for extension of the term of U.S. Patent No. 4,634,697 based on the CEDAX® (oral suspension) regulatory review period.

A duplicate original copy of this letter transmitted today by telefax is being deposited First Class mail in an stamped envelope addressed to the Assistant Commissioner for Patents, Box Patent Ext., Washington, D.C. 20231  
Attn: Hiram H. Bernstein.

Respectfully submitted,

*Thomas D Hoffman*  
Thomas D. Hoffman  
Authorized Attorney for Applicant  
Reg. No.: 28221  
Telephone No.: (908) 298-5037  
Telefax No.: (908) 298-5388

PATENT DEPT. K-6-1 1990  
SCHERING-PLOUGH CORPORATION  
2000 GALLOPING HILL ROAD  
KENILWORTH, NJ 07033

Certification of Facsimile Transmission

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

*Thomas D Hoffman*  
Type or print name of person signing certification  
\_\_\_\_\_  
Signature \_\_\_\_\_ Date \_\_\_\_\_  
Thomas D Hoffman 5/27/97

APR 25 1997



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

PATENT DEPARTMENT RECEIVED

APR 30 1997

105  
101

CASH  
 DRAFT  
 DEBIT NOTE  
COMPLETED

Thomas D. Hoffman  
Schering-Plough Corporation  
Patent Department (K-6-1-1990)  
2000 Galloping Hill Road  
Kenilworth NJ, 07033-0530

In Re: Patent Term Extension  
Application for  
U.S. Patent No. 4,634,697

### NOTICE OF FINAL DETERMINATION

A determination has been made that U.S. Patent No. 4,634,697, which claims the active ingredient, cefibuten dihydrate, of the human drug product CEDAX® (cefibuten dihydrate- oral suspension) and a method of use of cefibuten dihydrate, is eligible for patent term extension under 35 U.S.C. § 156, subject to the following requirement of election. The period of extension has been determined to be five years.

A single request for reconsideration of this final determination as to the length of extension of the term of the patent may be made if filed within one month of the date of this notice. Applicant is required to elect a single patent to be extended under 35 U.S.C. § 156 and a single regulatory review period upon which the extension will be based within one month of the date of this notice. Extensions of time under 37 CFR § 1.136(a) are not applicable to these time periods.

The period of extension has been calculated using the FDA determination of the length of the regulatory review period published in the Federal Register of August 27, 1996 (61 Fed. Reg. 44,068). Under 35 U.S.C. § 156(c):

$$\begin{aligned}
 \text{Period of Extension} &= \frac{1}{2} (\text{Testing Phase}) + \text{Approval Phase} \\
 &= \frac{1}{2} (1,179) + 1,462 \\
 &= 2,052 \text{ days}
 \end{aligned}$$

Since the regulatory review period began September 28, 1988, after the patent issue date (January 6, 1987), the entire period has been considered in the above determination. No determination of a lack of due diligence under 35 U.S.C. § 156(c)(1) was made.

However, the limitations of 35 U.S.C. § 156(g)(6) operate to reduce the period of extension determined above. The five year limitation of 35 U.S.C. § 156(g)(6)(A) applies in the present situation because the patent was issued after the date of enactment (September 24, 1984) of 35 U.S.C. § 156. Since the period of extension calculated under 35 U.S.C. § 156(c) for the patent cannot exceed five years under 35 U.S.C. § 156(g)(6)(A), the period of extension will be for five years.

The 14 year exception of 35 U.S.C. § 156(c)(3) does not operate to further limit the term of the extension in the present situation because fourteen years measured from the date of approval of the approved product is after the expiration date of the patent as extended (i.e., December 20, 2009 is

U.S. Patent No. 4,634,697

Page 2

after October 1, 2009).

It is noted that applicant has also filed applications for patent term extension of U.S. Patent No. 4,812,561 based upon the regulatory review of CEDAX® (ceftibuten dihydrate - capsules) and CEDAX® (oral suspension). No more than one patent may be extended for a regulatory review period of a single product. 35 U.S.C. § 156(c)(4). Furthermore, for a patent to be eligible for patent term extension, the permission for commercial marketing or use must be the first permitted commercial marketing or use of the product under the provision of law under which regulatory review occurred. See 35 U.S.C. § 156(a)(5). When applications are filed for extension of the terms of different patents based upon the same regulatory review period for a product, the certificate of extension is issued to the eligible patent having the earliest date of issuance unless applicant elects a different eligible patent. Therefore, only one of above-identified patent and U.S. Patent No. 4,812,561 can be extended based upon the regulatory review period of either CEDAX® (ceftibuten dihydrate - capsules) or CEDAX® (oral suspension). Furthermore, the extension can only be determined from a single regulatory review period. 35 U.S.C. 156(c). Accordingly, applicant is also required to elect a single regulatory review period upon which the extension will be based. In the absence of an election by applicant within ONE MONTH of the date of this notice, and in accordance with 37 CFR 1.785(b), an application for patent term extension in the above-identified patent will be granted based upon the regulatory review period of CEDAX® (ceftibuten dihydrate - capsules) and the above-identified application will be dismissed. If U.S. Patent No. 4,634,697 is elected based upon the regulatory review period of CEDAX® (ceftibuten dihydrate - oral suspension), the Commissioner will issue a certificate of extension, under seal, for a period of five years. Extension of time under 37 CFR 1.136(a) is NOT permitted.

If issuance of the certificate of extension occurs, the following information will be published in the Official Gazette:

U.S. Patent No.	:	4,634,697
Granted	:	January 6, 1987
Original Expiration Date	:	October 1, 2004
Applicant Owner of Record	:	Yoshio Hamashima Shionogi & Co., Ltd.
Title	:	CARBOXYALKENAMIDO- CEPHALOSPORINS
Classification	:	514/202

U.S. Patent No. 4,634,697

Page 3

Product Trade Name	CEDAX®
Term Extended	Five years
Expiration Date of Extension	October 1, 2009

Any correspondence from applicant with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents  
Box Patent Ext.  
Washington, D.C. 20231

By FAX: (703) 308-6916  
Attn: Special Program Law Office

By hand: One Crystal Park, Suite 520  
2011 Crystal Drive  
Arlington, VA

Telephone inquiries related to this determination should be directed to Karin Tyson at (703) 306-3159.

H. Bernstein  
Hiram H. Bernstein  
Senior Legal Advisor  
Special Program Law Office  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects

cc: Ronald L. Wilson, Director  
Health Assessment Policy Staff  
Office of Health Affairs (HFY-20)  
Food and Drug Administration  
5600 Fishers Lane, Room 15-22  
Rockville, MD 20857

RE: CEDAX® (oral suspension)  
FDA Docket No.: 96E-0099